

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KNUT CAESAR
and
NORBERT GREITSCHUS

Appeal No. 1997-3146
Application 08/558,670¹

ON BRIEF

Before MARTIN, FLEMING and BARRY, ***Administrative Patent Judges***.

¹ Application for patent filed November 16, 1995.

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FLEMING, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1 through 20, all the claims present in the application.

The present invention relates to a digital driver circuit wherein the digital driver circuit is capable of driving a variety of capacitive loads.

Independent claim 1 is reproduced as follows:

1. An integrated driver circuit for driving a given load capacitance, comprising:

an output stage having at least two parallel output branches, wherein each of said at least two parallel output branches includes a first transistor;

switching means coupled to said output stage for selectively turning on each of said at least two parallel output branches;

setting means coupled to said switching means for developing a setting signal that determines which of said at least two parallel output branches are selectively turned on; and

an output device coupled to said setting means for enabling a user to select said given load capacitance by providing a number corresponding to said given load capacitance, wherein said input device develops a numerical measure signal according to said number provided by the user, said numerical measure signal is received by said setting means to develop said setting signal.

No prior art has been relied upon by the Examiner in the rejection of the claims under appeal.

Claims 1 through 20 stand rejected under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which Appellants regard as the invention. The Examiner objected to Appellants' specification under 35 U.S.C. § 112, first paragraph, for failing to provide an enabling disclosure. Claims 1 through 20 stand rejected under 35 U.S.C. § 112, first paragraph, for being based upon the reasons set forth in the objection to the specification. Rather than repeat the arguments of Appellants or the Examiner, we make reference to the briefs² and the answer for the details thereof.

² On December 24, 1996, Appellants filed an appeal brief. On February 5, 1997, Appellants filed a reply brief. On March 3, 1997, the Examiner mailed an Office communication stating that the reply brief has been entered and considered but no further response by the Examiner is deemed necessary.

OPINION

After a careful review of the evidence before us, we do not agree with the Examiner that claims 1 through 20 are properly rejected under 35 U.S.C. § 112, first paragraph, or 35 U.S.C. § 112, second paragraph.

In order to comply with the enablement provision of 35 U.S.C. § 112, first paragraph, the disclosure must adequately describe the claimed invention so that the artisan could practice it without undue experimentation. ***In re Scarbrough***, 500 F.2d 560, 566, 182 USPQ 298, 303 (CCPA 1974); ***In re Brandstadter***, 484 F.2d 1395, 1404, 179 USPQ 286, 293 (CCPA 1973); and ***In re Gay***, 309 F.2d 769, 774, 135 USPQ 311, 316 (CCPA 1962). If the Examiner had a reasonable basis for questioning the sufficiency of the disclosure, the burden shifted to the Appellants to come forward with evidence to rebut this challenge. ***In re Doyle***, 482 F.2d 1385, 1392, 179 USPQ 227, 232 (CCPA 1973), ***cert. denied***, 416 U.S. 935 (1974);

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In re Brown, 477 F.2d 946, 950, 177 USPQ 691, 694 (CCPA 1973); and *In re Ghiron*, 442 F.2d 985, 992, 169 USPQ 723, 728 (CCPA 1971). However, the burden was initially upon the Examiner to establish a reasonable basis for questioning the adequacy of the disclosure. *In re Strahilevitz*, 668 F.2d 1229, 1232, 212 USPQ 561, 563 (CCPA 1982); *In re Angstadt*, 537 F.2d 498, 504, 190 USPQ 214, 219 (CCPA 1976); and *In re Armbruster*, 512 F.2d 676, 677, 185 USPQ 152, 153 (CCPA 1975).

We fail to find that the Examiner had a reasonable basis for questioning the sufficiency of the disclosure. In particular, the Examiner has not shown that the artisan would not have been able to practice the claimed invention without undue experimentation.

On pages 3 through 5 of the Examiner's answer, the Examiner argues that the specification is nonenabling because the details of the control means 22 and the setting means 24 are not set forth. However, the Examiner does not provide a reasonable basis for showing that the artisan would not have

been able to provide the control means 22 and the setting means 24 without undue experimentation.

On page 6 of Appellants' specification, Appellants disclose the setting means 24 as shown in figure 1. In particular, Appellants teach that the setting means 24 develops a setting signal S that determines which output branches 16A, 16B, 16C, 16D are enabled. On page 10 of Appellants' specification, Appellants disclose that the setting means 24 may also include an A/D converter 28. Appellants disclose that the setting means 24 includes a processor which generates a setting signal S which is adapted to the process parameters by the numerical measure signal M and the correction signal K. The calculation is based upon either a table included in the program or may be done directly. Appellants further disclose on page 6 that the control means 22

is a well-known switching device that is used to activate the output stage 14. From the disclosure, we find that the control means 22 and the setting means 24 could have been made

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by an artisan using well-known compounds in the computer arts.

We agree with the Examiner that the details of the control means 22 and the setting means 24 are not set forth in the specification. However, 35 U.S.C. § 112, first paragraph, does not require the Appellants to disclose shop drawings of their invention. Appellants must provide a disclosure that adequately describes the claimed invention so that the artisan would have been able to practice the invention without undue experimentation. We find that Appellants have provided a disclosure of the control means 22 and setting means 24 such that an artisan would have been able to practice the invention without undue experimentation. Thus, the Examiner has not provided a reasonable basis for questioning the sufficiency of the disclosure. Therefore, we will not sustain the Examiner's rejection of Appellants' claims 1 through 20 under 35 U.S.C. § 112, first paragraph.

Claims 1 through 20 stand rejected under 35 U.S.C. § 112, second paragraph, for failing to particularly point out

and distinctly claim Appellants' invention. The Examiner argues that Appellants' recital that the user selects a given load capacitance by inputting a number into the input device is not correct. The Examiner also argues that the claim language is also indefinite because the phrase "in parallel" is indefinite because no details have been given in the specification or claims as to how the branches 16A through 16D are "in parallel."

Analysis of 35 U.S.C. § 112, second paragraph, should begin with the determination of whether claims set out and circumscribe the particular area with a reasonable degree of precision and particularity; it is here where definiteness of the language must be analyzed, not in a vacuum, but always in light of teachings of the disclosure as it would be interpreted by one possessing ordinary skill in the art. ***In re Johnson***, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977), ***citing In re Moore***, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (1971). Furthermore, our reviewing court points out that a claim which is of such breadth that it reads on subject matter disclosed in the prior art is rejected under 35 U.S.C.

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§ 102 rather than under 35 U.S.C. § 112, second paragraph.
See *In re Hyatt*, 708 F.2d 712, 715, 218 USPQ 195, 197 (Fed.
Cir. 1983) citing ***In re Borkowski***, 422 F.2d 904, 909, 164 USPQ
642, 645-46 (CCPA 1970).

Turning to claim 1, Appellants recite "an input device . . . for enabling a user to select said given load capacitance by providing a number corresponding to said given load capacitance." We find that this claim language does set out and circumscribe a particular area with a reasonable degree of precision and particularity when viewed in light of the teachings of the disclosure. From the claim language in the disclosure, it is clear that the Appellants are claiming that a user selects a value that is inputted into the driver which determines the load capacitance. We note that on page 4 of the reply brief, Appellants argue this very point.

The Examiner also argues that the phrase "in parallel" is indefinite. We note that the Examiner has not pointed to the particular claim in which this language is found. Turning to claim 1, we note that Appellants claim an

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